

REMARKS

Applicants have received and carefully reviewed the Office Action mailed May 7, 2007. Claims 56, 61-63, 71, 73, 94, and 105 have been amended and new claim 111 has been added. Support for the amendments and new claim is found in the specification, claims, and drawings as originally filed. Claims 56, 61, 62, and 73 have been amended to clarify the access path. Claims 63, 71, 94, and 105 have been amended to clarify the relationship between discrete segments. No new matter has been added. Reconsideration and allowance of the pending claims are respectfully requested.

Inventorship and Corrected Filing Receipt

A request to correct inventorship under 37 C.F.R. §1.48(c) was filed on January 19, 2006. With that filing, Applicants additionally requested the issuance of a corrected filing receipt reflecting the change of inventorship. Applicants have not yet received an indication that the inventorship has been corrected, and have not yet received a corrected filing receipt reflecting the change of inventorship. Applicants respectfully request that these be issued in due course.

Information Disclosure Statement

An initialed copy of the 1449 submitted with the IDS filed March 5, 2004 has not been received. Applicants respectfully request the Examiner consider the cited references and provide a copy of the initialed 1449 with the next Office Action.

Rejection under 35 U.S.C. § 102(b)

Claims 56-74 and 76-110 are rejected as being anticipated by Kogasaka et al. (EP 0807415A2). The Examiner asserts that Kogasaka et al. disclose a retractor 401, a trocar as a dilator for introduction of retractor 401, at least five discrete segments 444 radially expanding in a non-linear manner, and a hollow tube 447 to receive a combination of a feed/suction tube and forceps and inherently a process including steps substantially as recited in the claims. Applicants respectfully disagree.

MPEP 2131 states that, in order to anticipate a claim, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868

F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." Applicants submit that Kogasaka et al. do not appear to teach the method steps in as complete detail as is contained in the claims.

Independent claims 56, 65, 74, 87, and 99 each, in part, recite:

moving a plurality of discrete segments of the retractor away from each other to retract tissue adjacent the spinal location

Emphasis added. Applicants submit that Kogasaka et al. do not appear to teach or suggest this. Kogasaka et al. teach:

When the surgery stripper with the above-described constitution is pressed lightly against a site of a body cavity from which it is desired to remove tissues, it is possible to strip the site of tissues.

. . .

As seen from above, as the surgery stripper of this embodiment includes the water feed/suction channel through the insert 401 and the body 402, it allows the cavity to be washed through water feed/suction, and the site of bleeding to be checked while the operation necessary for stripping is in progress. This device dispenses with replacement of forces for water feed or water suction during operation and thus shortens time required for operation.

See column 65, lines 53-56 and column 66, lines 10-18. Kogasaka et al. thus does not appear to teach expanding a retractor to retract tissues, but rather appears to teach stripper insert 401 as providing fluid feed and suction for stripping tissues. Kogasaka et al. also teach:

As shown in Fig. 111A, the external surface of the treatment segment 442 is covered with a mesh 443, and in its interior is placed an elastic member 444 which takes a nearly cylindrical form and is made of silicone or a spring material. The mesh 443 is knitted by a thread made of a resin such as nylon and has a contractility.

. . .

As shown in Fig. 112, along the long axis of the elastic member 444 are implemented slits 448 with an equal distance between adjacent ones in circumference.

. . .

Although in this embodiment the elastic member 444 in the form of a cylinder has slits on its perimeter, the elastic member 444 may be composed of a plurality of strips which are then arranged into a cylinder.

See column 69, lines 47-52, column 70, lines 2-5 and 39-43. The device of Kogasaka et al. does not appear to have a plurality of discrete segments that retract tissue when moved away from each other, as is recited in the independent claims. The elastic member 444 with slits 448 of Kogasaka et al. appears to provide a means of delivering and removing fluid from an operation site. Applicants submit that the claimed method step of "moving a plurality of discrete segments of the retractor away from each other to retract tissue" is not inherent in Kogasaka et al.

The Examiner is considering the specific method steps recited in the claims to be inherent in Kogasaka et al. Applicants submit that there is no basis for such an interpretation. MPEP 2112 IV. states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

(Emphasis added). Applicants submit that the claimed method, in particular the "moving a plurality of discrete segments of the retractor away from each other to retract tissue adjacent the spinal location", is not necessarily present in Kogasaka et al. It appears the Examiner is asserting that the claimed method steps could be performed by the system of Kogasaka et al., which is not a proper basis for rejection.

Independent claim 65 further recites, "pivoting the distal portion relative to the proximal portion." Kogasaka et al. do not appear to teach or suggest this. The Examiner has not addressed this element of the claim. If this rejection is maintained, the Examiner is respectfully requested to point out where in Kogasaka et al. such a teaching is found.

Independent claim 87 further recites, in part, "wherein the discrete segments are moved away from each other by being guided incrementally along successive notches of a guiding mechanism." Claim 96 recites, "wherein each of said notches maintains a desired configuration

of said retractor," claim 97 recites, "wherein each of said notches prevents the retractor from moving from an expanded configuration to a contracted configuration," and claim 98 recites, wherein the guiding mechanism comprises at least three notches." Kogasaka et al. do not appear to teach or suggest these. The Examiner asserts that "notches" are interpreted as different steps or degrees of expanding of discrete segments 444. Applicants respectfully disagree. Kogasaka et al. do not appear to teach or suggest notches or a guiding mechanism, other than the tube 447, which does not appear to have notches or any other structure that would be expected to allow the segments 444 to move away from each other incrementally. The Examiner has not provided any reasoning for the interpretation of "notches of a guiding mechanism" on the structure or Kogasaka et al. Further, the Examiner has not provided any reasoning for why one of ordinary skill in the art would interpret the method steps of Kogasaka et al. as including the claimed method step. Kogasaka et al. thus do not appear to teach the identical method steps in the same detail as is recited in claims 87 and 96-98.

Independent claim 107, in part, recites:

expanding the retractor by separating a first retractor blade from a second retractor blade by moving at least one of the first retractor blade and the second retractor blade along a first connector of the retractor, and

separating a third retractor blade from a fourth retractor blade by moving at least one of the third retractor blade and the fourth retractor blade along a second connector;

Kogasaka et al. do not appear to teach or suggest these limitations. In particular, the segments 444 of the elastic member appear to expand away from each other as the rod 447 is withdrawn, but Kogasaka et al. do not appear to teach or suggest moving any of the segments 444 along a connector, as is recited in the claim.

For at least the reasons set forth above, Kogasaka et al. do not appear to teach the identical method steps in the same detail as is recited in claims 56-74 and 76-110. Kogasaka et al. thus cannot be seen to anticipate the claims. Further, there is no motivation for one of ordinary skill in the art to modify the method of Kogasaka et al. to achieve the claimed method steps. Reconsideration and withdrawal of the rejection are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claim 75 is rejected as being unpatentable over Kogasaka et al. (EP 0807415A2). Applicants respectfully traverse this rejection. As an initial matter, claim 75 is dependent upon independent claim 74, and as indicated above, Kogasaka et al. does not teach or suggest all of the elements of claim 74. As such, claim 75 is also allowable over Kogasaka et al.

Further, the Examiner acknowledges that Kogasaka et al. fails to teach using dilators/trocars to dilate a tissue, but asserts that it is common sense to have trocars of different size for a choice of use and it would have been obvious to provide a physician more than one trocar for dilating and create smaller or larger passages as the physician sees fit. Applicants respectfully disagree.

Kogasaka et al. teach, "[t]he treatment segment with the above constitution is inserted through a trocar not illustrated here into the body: as shown in Figs. 111A or 112A, before insertion, it is allowed to take a cylindrical form which has a similar outer diameter to that of the insert 441." See column 70, lines 14-18. Kogasaka et al. do not appear to teach or suggest using a plurality of dilators, as is recited in claim 75.

The Examiner appears to be taking Official Notice with respect to claim 75, asserting that the concept of using a plurality of dilators is well known and expected in the art. Applicants submit that the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known, especially in the context of the present invention. Per MPEP 2144.03(C), Applicants respectfully traverse the taking of Official Notice and request the Examiner provide documentary evidence supporting the rejection in the next office action if the rejection is maintained.

Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney.

Respectfully submitted,

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By his Attorney,

Date:

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